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In The

SUPREME COURT of the UNITED STATES

OCTOBER TERM 1957

No. 533

PARKS-CRAMER COMPANY, a Corporation of Massachusetts,
Petitioner

vs.

THE AMERICAN MONORAIL COMPANY, a Corporation of Ohio,
Respondent

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT AND APPENDIX

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

To the Honorable, The Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Petitioner respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fourth Circuit reversing a final judgment of the United States District Court for the Western

District of North Carolina, wherein originally the petitioner was plaintiff and the respondent was defendant.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Fourth Circuit is reported at 245 F. 2d 739 and appears as Appendix A to this petition. The opinion of the United States District Court for the Western District of North Carolina is reported at 147 F. Supp. 218 and appears at page 171a[1] of the Record.

JURISDICTION

The opinion and judgment sought to be reviewed were entered by the United States Court of Appeals on May 27, 1957, and appear as Appendix A and B of this petition. Petitioner's timely petition for a rehearing was denied on July 10, 1957. The jurisdiction of this Court to review by writ of certiorari the judgment in question is conferred by Title 28, United States Code, Section 1254 (1).

QUESTIONS PRESENTED

(1) Did the Court of Appeals err in reversing the trial court and holding that the patent in suit was invalid

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[1] Copies of the record as printed for use of the United States Court of Appeals for the Fourth Circuit are filed herewith pursuant to Rule 21(4). Such record consists of a blue pamphlet labeled "Appendix of Appellant" containing pages 1a to 181a and a gray pamphlet labeled "Appendix for the Appellee" containing pages 1x to 64x.

for lack of invention, despite the trial judge's findings of fact that

(a) the textile cleaning industry was continually on the look out for and in need of a means of solving the problem which the patentee overcame;

(b) many men skilled in the art of textile cleaning, including defendant's research men, were continuously undertaking to devise some means for solving the problem;

(c) the patentee's solution of the problem met a ready response from the textile industry and has been highly successful commercially;

(d) the defendant and other competitors who had previously offered other solutions to the industry found that such products were not competitive and turned to copying the patentee's device?

(2) Did the Court of Appeals err in applying an improper test of what constitutes patentable invention in view of the enactment of Section 103 of Title 35 of the U. S. Code?

(3) Did the Court of Appeals err in holding that the standard of what constitutes patentable invention is a legal rather than a factual one?

STATEMENT OF THE CASE

A principal problem in the manufacturing of textile yarns and fabrics made from cotton and other short staple fibers is the collection of lint which is shed during the manufacturing operations, collects on the textile machines, forms

bunches and frequently becomes caught in the yarns as they are drawn, spun, wound and woven, causing slubs and other imperfections in the yarns and fabric. The bunches often cause breaks which require piecings, resulting in further imperfections. A major item, therefore, in the cost of textile manufacture lies in keeping the textile machines, room surfaces and material in process reasonably free from such lint. This fact is of particular importance with reference to the spinning room.

Prior to about 1926, cleaning of spinning frames was done by hand (23a). The spinning room operatives would wipe or brush off the surfaces where lint had accumulated, or would blow the lint off by fanning. In some mills certain portions of spinning frames such as underframe and ring rail areas were cleaned periodically by compressed air (23a). The air was piped into the room and a long flexible hose was attached. This hose had a metal or other rigid nozzle on the end, which the operative would direct at surfaces to be cleaned (24a). Since about 1926 traveling blowers, running continuously on a track above rows of textile machines, such as cotton ring spinning frames, winders, twisters, spoolers, warpers and, more recently, looms have been widely used. These "traveling cleaners" blow the lint off such machines at approximately five minute intervals.

The air distributing outlets in the early cleaners terminated above the machines and above the heads of the machine operators when standing. This is illustrated by a photograph of one of those early cleaners (the Hodge cleaner), appropriately marked to identify various parts of the spinning frame, reproduced on facing page. (Plaintiff's Exhibit 1.) The Hodge frame cleaner, riding on a track above the spinning frame, is the cleaner on the right of the

photograph, identifiable by the presence of air ducts extending toward the frame. This cleaner, along with the Walker-Smith type (Plaintiff's Exhibit 13, 61x) and Lawrence type (Plaintiff's Exhibit 3, 56x) typify the early cleaners which were in use. All of these were manufactured and sold by either plaintiff or defendant.

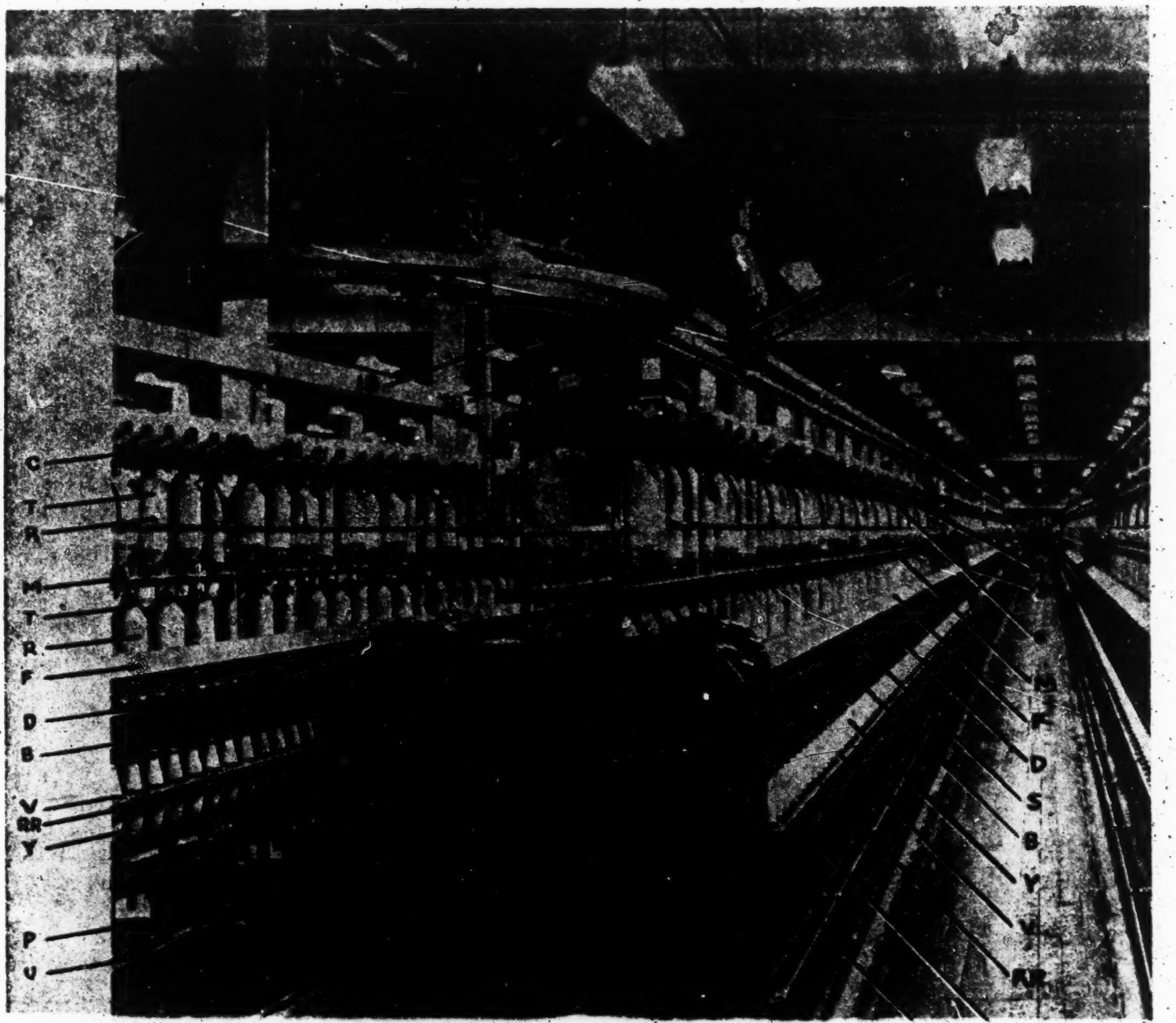
Prior to the invention represented by the patent in suit, No. 2,524,797, issued in 1950, certain areas of spinning frames such a undersides of the top, middle an bottom creel boards (C, M and D on Plaintiff's Exhibit 1) were not cleaned by the overhead traveling blowers (5x, 9x, 37x). No way had been found of delivering air from traveling blowers to these out-of-line areas. The lower outside surfaces of these machines, such as ring rail (RR), travelers (V), etc., also could not be cleaned effectively since no way had been found of reaching such surfaces with air of sufficient intensity to keep them clean without creating air currents too strong for intermediate areas of the machine, such as the roving and drafting rolls (5x-6x, 39x-40x). As a rule these lower frame surfaces and underframe areas were cleaned during shut down periods by the use of compressed air (34x, 39x).

Numerous attempts were made to improve early types of traveling cleaners and to devise special cleaners for certain areas. These attempts were far from successful. At best only slightly better cleaning resulted. A good deal of hand cleaning still had to be done and machines had to be stopped periodically for more thorough blowing off. This labor was expensive; some production time was lost; and the quality of the product suffered.

Faced with the problem of devising better means of

Plaintiff's Exhibit

Early Hodge Cleaner



cleaning out-of-line and otherwise hard-to-reach areas effectively, plaintiff's Research Director, Grover B. Holtzclaw, conceived the novel idea of using extended air outlets (cuffs, nozzles or sleeves) of appropriate shape and size to deliver air currents of the right volumes and velocities at the right places and in the right directions, such outlets being made of flexible material in order to yield if they should come in contact with a machine operator or other obstruction, as the cleaner traveled along at a speed of 100 feet or more per minute. The invention had three important components, each of which was novel in the traveling cleaner art: (1) conveying air currents down below head height into the working area of the room close to surfaces to be cleaned, (2) directing the issuing air currents accurately at controlled volumes and velocities and against surfaces not previously cleanable, and (3) employing flexible materials in making the extended sleeves to insure safe operation without injury to operatives or equipment.

Although the embodiment of the invention illustrated in the patent featured relatively short flexible cuffs or sleeves, the inventor also contemplated the use of longer and multiple sleeves if necessary to a thorough cleaning of the machines (10a-11a, 26x). Numerous embodiments were developed by the inventor over a period of years following the issuance of his patent, to which the defendant contributed nothing. A photograph of the plaintiff's "elephant trunk" embodiment, the device copied by the defendant in 1954 (43x-44x) appears on facing page, in the process of striking and passing over an employee (Plaintiff's Exhibit 16). It is to be noted that this elephant-type cleaner contained short sleeves with curved end portions as illustrated in the patent in suit and also longer sleeves featuring a variety of nearly horizontal inwardly directed air outlets

for cleaning many different frame areas, including the underframe.

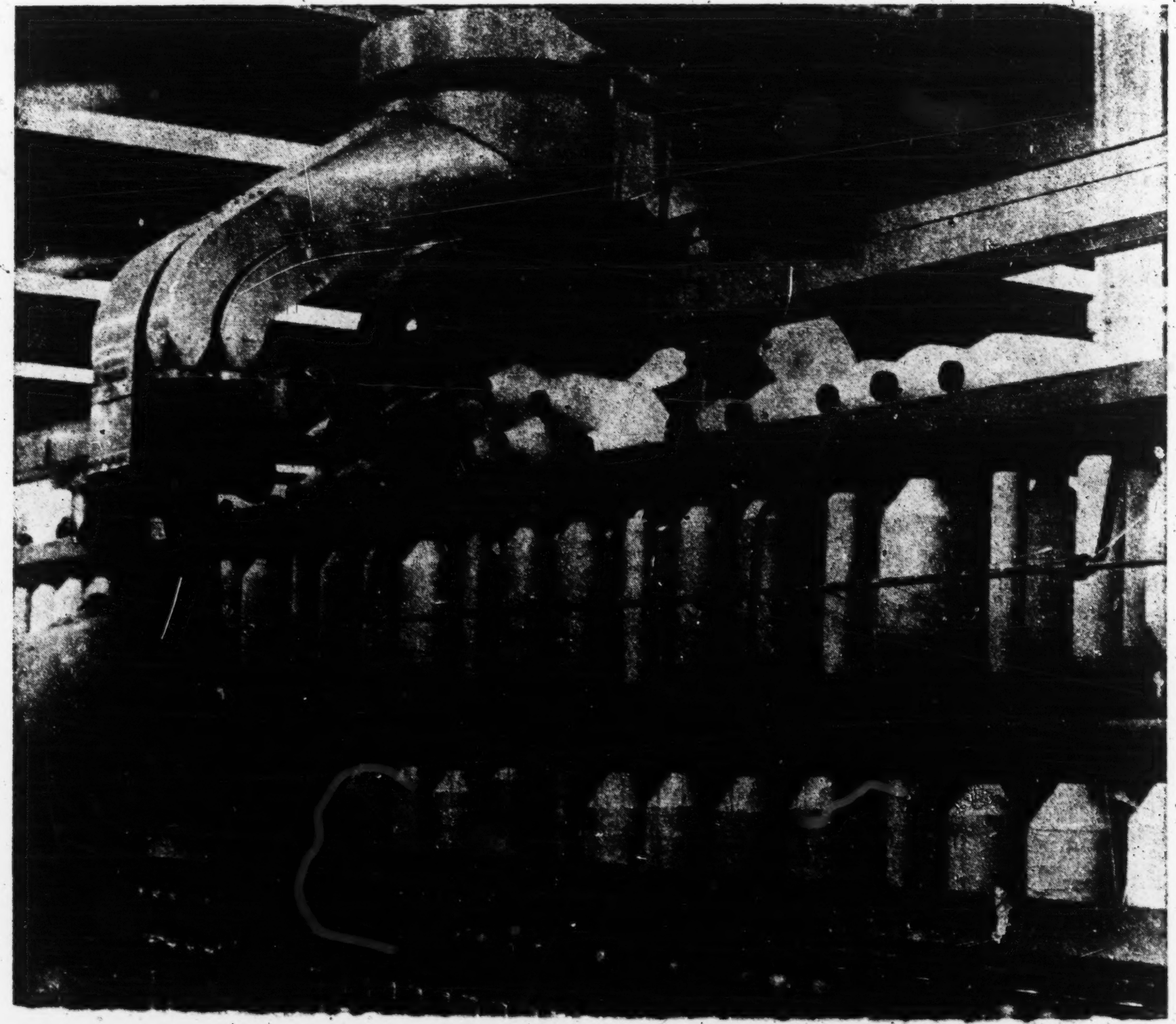
In December of 1954, plaintiff learned that defendant had made and installed equipment which infringed its patent No. 2,524,797 and shortly thereafter plaintiff instituted this action under Title 28, § 1338(a) of the United States Code. The trial court held the plaintiff's patent valid and infringed by the defendant (180a). On appeal by the defendant, the judgment of the trial court was reversed by the Court of Appeals on the ground that the patent in suit is invalid for lack of invention. Plaintiff's petition for a rehearing was denied.

REASONS FOR ALLOWANCE OF WRIT

Introduction

This is a case in which the United States Court of Appeals for the Fourth Circuit, in overthrowing the trial court's finding of validity, improperly and contrary to the requirements of Section 103 of Title 35 of the United States Code and the decisions of this Court took no account of the fact that many persons skilled in the trade had over a number of years sought unsuccessfully to solve the problem which this patentee finally overcame. Despite the trial court's finding of fact, the Court of Appeals' opinion made no mention of such unsuccessful prior attempts, holding the patent invalid for lack of invention on the basis of some purely subjective and theoretical test unrelated to the talents of a person having ordinary skill in the art. In so doing, the United States Court of Appeals for the Fourth Circuit (1) rendered a decision which conflicts with principles of law enunciated in the decisions of other circuit

Plaintiff's Exhibit 16.
"Elephant" Type Holtzclaw Cleaner and Operator



courts of appeals; (2) decided an important question of federal law, to wit, that Section 103 of Title 35 of the United States Code does not restrict the scope of an appellate court's inquiry to the issue of whether or not the invention was obvious to a person having ordinary skill in the art, which question has not been, but should be, settled by this Court; and (3) so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

I. The Court Of Appeals Erred In Holding That The Patent In Suit Was Invalid For Lack Of Invention Despite The Fact That Many Others Skilled In The Art Had Made Numerous Attempts To Solve The Industry's Problem Without Success And The Petitioner's Device Has Enjoyed Great Commercial Success.

That there was a marked and long-felt need for a cleaner which would perform the cleaning job made possible by the Holtzclaw invention has been demonstrated by the testimony of plaintiff's witnesses (7x, 37x). Two of plaintiff's witnesses were mill executives who have been confronted with the problem from day to day. Additional evidence of such long-felt need is contained in prior art patents which bear witness to the many other attempts of men skilled in the art to solve this cleaning problem.

Plaintiff's testimony has also shown the marked commercial success which the Holtzclaw flexible sleeve cleaner has enjoyed. (22x). In the calendar year 1955 alone, plaintiff sold to 155 mills 1,395 such cleaning units operating over approximately three and one-third million spindles, which is equal to about one-seventh of the spindles in use in the United States. The gross sales price of such cleaning

units in 1955 aggregated three and a half million dollars (32x).

As was indicated by the district judge's finding of fact, "many men skilled in the art of textile cleaning were continuously undertaking to devise some means for cleaning the lint from the various surfaces of such machines not cleaned by the machines (traveling cleaners) of the Walker and Lytton types. . . Holtzclaw has evidently overcome the problem which confronted the industry for many years and has devised by his invention a means and a method to deliver air to out of line surfaces and at a correct velocity and in such volume as is found proper." (173a, 176a). Prior to Holtzclaw's invention the problem of cleaning textile machines was made more difficult by the fact that different areas were found to require air streams of different velocities and directions in order to provide effective cleaning without interfering with efficient machine operation and impairing yarn quality. For example, in the roving and drafting areas, not much air is permissible; velocities here must be restricted to only a few hundred feet per minute in order to avoid impairing the quality of the yarn. Midway of the spinning frame, somewhat higher velocities are required to reach under the drafting rolls and clean associated areas. Still farther away from the overhead traveling unit, still higher velocities are needed for cleaning the spindle areas. The most remote areas to be cleaned, namely, within the underframe, require air velocities many times greater than are permissible up in the creel area.

Major attempts to solve the problem included (1) dividing the air conduits of overhead traveling cleaners, making them wider so as to provide some adjustability in the direction of the issuing air currents, (2) adding adjustable

air deflectors of various sorts, and (3) installing entirely separate blower equipment within the underframe.

Certainly Holtzclaw's solution of the problem of cleaning an entire textile machine from an overhead traveling cleaner was not obvious to Hodge (plaintiff's exhibits 24, 25, 28, and 30), nor to Smith (plaintiff's exhibit 29), nor to Moore (plaintiff's exhibit 27), whose attempts were made over a considerable period of years. Nor was the solution obvious to Holtzclaw himself. He did not develop the cleaner in suit until some ten years after his Parks-Cramer predecessor Hodge had obtained cleaner patents, despite the fact that he was constantly engaged in development and research work.

And certainly the solution was not obvious to the defendant who, even after Holtzclaw's application had been filed, publicly admitted in another patent application that the problem was insoluble (Miller and Becker patent No. 2,516,475, plaintiff's exhibit 8, Col. 1, line 31):

> "Ever since spinning frames were first used the problem of removing lint from them or preventing its accumulation on them has existed and many proposals have been made to solve this problem. . . .
>
> Air streams could theoretically be used to effect the desired cleaning but the problem of generating such streams and delivering them against all the parts in the underframe to be cleaned has apparently been insoluble. . . A traveling air stream could not be applied effectively from outside the frame. . . "

Lack of obviousness of the Holtzclaw solution is thus especially demonstrated by the work of Miller and Becker,

defendant's inventors, who went to great lengths to develop for the defendant the special underframe cleaner disclosed in their patent. As shown by the record in the present case, the Miller and Becker cleaner proved to be practically non-saleable in competition with the improved cleaner of the Holtzclaw patent in suit. Defendant has virtually abandoned its Miller and Becker underframe cleaner and has instead copied plaintiff's Holtzclaw cleaner. We submit that it is inconceivable that the defendant should have made the investment involved in developing and selling its expensive underframe cleaner of the Miller and Becker patent, if, as defendant now contends, it were obvious all the time that air for cleaning could be conveyed to the underframe areas by an overhead cleaner employing Holtzclaw's flexible ducts.

Despite the significance of these many prior unsuccessful attempts, no reference whatever was made to them in the opinion of the Court of Appeals in which the decree of the trial court was reversed.

That such considerations may be determinative was indicated by Justice Roberts when writing for this Court in *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275, 278, 64 S. Ct. 593, 594 (1944) a case in which the validity of a patent relating to a leakproof dry cell for a flashlight battery was sustained:

> "The District Judge made findings, which have support in the evidence, to the following effect: That the problem presented was old and no solution was attained prior to Anthony's invention; that the respondent began marketing the patented cell in 1939 and was the first to guarantee its product against sticking in the

flashlight case; that the cell met with immediate commercial success due to the advantages of its construction and not to extensive advertising . . . In his opinion he examined the prior art and showed that none of the workers in the art had met the problems of leakage and swelling in the way suggested by Anthony and that most of the citied patents had not in fact been addressed to these problems."

* * *

"Viewed after the event, the means Anthony adopted seem simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention. During a period of half a century, in which the use of flashlight batteries increased enormously, and the manufacturers of flashlight cells were conscious of the defects in them, no one devised a method of curing such defects. Once the method was discovered it commended itself to the public as evidenced by marked commercial success. These factors were entitled to weight in determining whether the improvement amounted to invention and should, in a close case, tip the scales in favor of patentability. Accepting, as we do, the findings below, we hold the patent valid and infringed."

As is indicated in Judge Learned Hand's opinion in *Safety Car Heating and Lighting Co.* v. *General Electric Co.*, 155 F. 2d 937 (CCA 2nd 1946), the very best test of what constitutes patentable invention has always been the *pragmatic* one of considering the industry's need for the invention, the number of those who sought to meet that need, the result accomplished by the invention, and

the reception which the invention received in the market. Judge Hand more recently emphasized the same considerations as determinative in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, 535 (CCA 2nd 1955), cert. denied 350 U. S. 911, rehearing denied 350 U. S. 955 (1956). There he stated:

> "The most competent workers in the field had for at least ten years been seeking a hardy, tenacious coating to prevent reflection; there had been a number of attempts, none satisfactory; meanwhile nothing in the implementary arts had been lacking to put the advance into operation; when it appeared, it supplanted the existing practice and occupied substantially the whole field. We do not see how any combination of evidence could more completely demonstrate that, simple as it was, the change had not been 'obvious * * * to a person having ordinary skill in the art'—§ 103."

Clearly the Court of Appeals for the Fourth Circuit violated the fundamental principles of patent law by disregarding these pragmatic tests of invention and indulging in a theoretical subjectivity in which hindsight played the leading role.

II. The Court Of Appeals Erred In Failing To Recognize That Section 103 Of Title 35 Of The United States Code Requires It To Determine Existence Of Invention By Reference To What Was Obvious To A Person Having Ordinary Skill In The Art.

We have already pointed out that this Court and other federal courts have held that the *most satisfactory* means of determining the existence of invention is by examining

the extent to which the industry needed the invention, the number of unsuccessful attempts to satisfy such need, and the acceptance of the invention by the industry. That this test was not applied by the Court of Appeals in the principal case is demonstrated not only by the failure of that Court's opinion to mention the numerous prior unsuccessful attempts which have been made to solve the textile cleaning problem but also by that Court's holding of invalidity in the face of such attempts.

The appellate court's error is made particularly apparent by the fact that Section 103 of Title 35 of the United States Code was enacted by Congress in 1952 in order to stabilize the pragmatic test as *determinative*, assuming, of course, that the invention also satisfies the other statutory tests laid down in Sections 101 and 102. Since there is no question but that the requirements of Sections 101 and 102 were satisfied by the patent in suit, the holding of the Court of Appeals cannot stand if that Court failed to apply the mandate of Section 103 correctly. We submit that its failure to do so is evident.

Section 103 provides as follows:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

A proper interpretation of Section 103 requires that a patent which satisfies the requirements of that Section and Sections 101 and 102 must be sustained. While the wording of Section 103 is somewhat ambiguous in this respect, the intent of the legislators, as derived from Reviser's Notes, the committee reports and the background of its enactment, was to stabilize the test of invention by pin-pointing *the* standard by which invention should be judged, thus forestalling great departures of the kind which appear in some recent cases and restoring public confidence in patents.

The Reviser's Note reads as follows:

> "There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. *This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.*
>
> The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius." (Emphasis added)

It will be noted that the second sentence of the Note indicates that Section 103 is intended to have a "stabilizing effect". If the courts remain free to apply a stricter test of

invention than that set out in Section 103, it is difficult to understand wherein that Section could have any stabilizing effect. Moreover, the fact that the second sentence of Section 103 expressly repudiates the "flash of genius" test referred to in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 62 S. Ct. 37 (1941), lends further support to the view that at least some substantive change in the law was intended.

Both the House and Senate Reports contain the following statement:

> "That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and *minimize great departures which have appeared in some cases.*[2] (Emphasis added)

The above statement is an almost verbatim quotation from the testimony of P. J. Frederico, then Examiner in Chief of the Patent Office, given at the hearings of the House subcommittee.[3] In his "Commentary on the New Patent Act," 35 U.S.C.A. 1 at 22, Mr. Frederico confirms that the "great departures" to which he referred were in the direction of greater strictness.

The House and Senate Reports also contain the following statement, indicative of an intention on the part of the legislators to breathe substantive life into Section 103:

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[2] H. R. Rep. No. 1923, 82d Cong., 2d Sess. 7 (1952); S. Rep. No. 1979, 82d Cong., 2d Sess. 6 (1952).

[3] Hearings before Subcommittee No. 3 of House Committee on Judiciary, 82d Cong. 1st Sess. 38 (1951).

"Although the principal purpose of the bill is the codification of title 35, United States Code, and involves simplification and clarification of language and arrangement and elimination of obsolete and redundant provisions *there are a number of changes in substantive statutory law.* These will be explained in some detail in the revision notes keyed to each section which appear in the appendix of this report. *The major changes or innovations in the title consist of incorporating a requirement for invention in § 103* and the judicial doctrine of contributory infringement in § 271."[4] (emphasis added)

On the basis of such evidence as that outlined above, one commentator has drawn the following conclusion:

"If any firm conclusion can be drawn with respect to the intent of Congress, it is that Congress intended section 103 to be the sole and exclusive test applicable when the question of invention was in doubt. As has been pointed out above, one may not deduce this proposition simply from the language of the statute itself, but it is believed that one cannot absorb the atmosphere of the hearings and the reports without attaining moral certainty that Congress intended that henceforth the courts should find noninvention only where the subject matter 'would have been obvious' to one skilled in the art. In what other way could it reasonably be supposed that the law would achieve 'uniformity and definiteness'? Unless all other tests of invention were eliminated, how could it be hoped that section 103 would

[4] H. R. Rep. No. 1923, 82d Cong., 2d Sess. 5 (1952); S. Rep. No. 1979, 82d Cong., 2d Sess. 4 (1952).

B Thread board, thread guides
C Top creel board
CT Hodge type traveling cleaner
D Bottom creel board, roller beam greenboard, deck (underframe area is below this)
F Flat clearer (revolving clearer is used on some frames)
J Samson
M Middle creel board
O Rigid air outlets
P Weight
R Roving bobbins
RR Ring rail
S Roll stands
T Top tapers
U Rocker
V Travelers
X Spindle rail
Y Finished yarn on spindle
Z Guard rail

have a 'stabilizing effect' or serve as the basis for some additional criteria 'which may be worked out' at a later time? It seems inescapable that the 'obviousness' test was established as the sole means of invalidating or refusing a patent for lack of invention. While this proposition appears elementary on its face, and probably few would quarrel with it, its full significance has not been realized."[5]

A somewhat similar conclusion was reached by Judge Learned Hand in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, 535 (CCA 2d 1955), cert. den. 350 U. S. 911, rehearing den. 350 U. S. 955 (1956). There Judge Hand held that, since the patentee in that case had solved a problem on which the most competent workers in the industry had been working for at least ten years, the patent satisfied the test of Section 103 and was consequently entitled to be sustained. In so holding, Judge Hand conceded that the patent would not have met the strict test of invention imposed by certain pronouncements of this Court in the decade prior to the enactment of Section 103. In support of this analysis of Section 103, see also *L-O-F Glass Fibers* v. *Watson*, 228 F. 2d 40, 47 (Ct. of Custs. & Pat. App'ls. 1955) and *Gentzell* v. *Manning*, 230 F. 2d 341, 344 (CCA 2d 1956), cert. denied 352 U. S. 840, 77 S. Ct. 63.

On the other hand, the principal case is not the first in which the Court of Appeals for the Fourth Circuit has refused to recognize the substantive effect of Section 103. See *Interstate Rubber Products Corp.* v. *Radiator Specialty*

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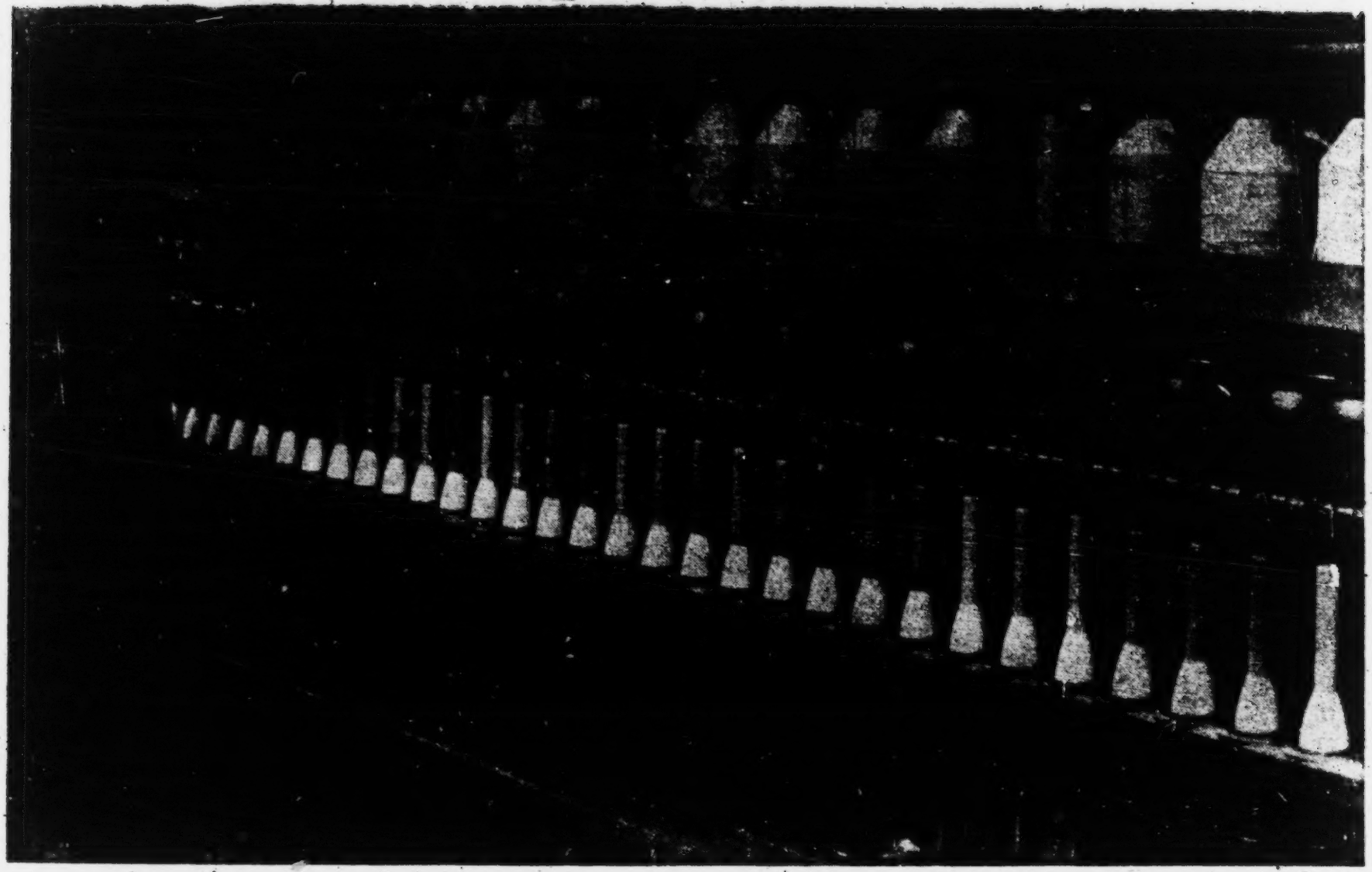
[5] Libert, "Section 103 of the Patent Act and the Standard of Invention: Comments on *Lyon* v. *Bausch & Lomb Optical Co.*," 38 J. Pat. Off. Soc'y. 304, 325 (1956).

Co., 214 F. 2d 546, 548 (CCA 4th 1954). And some other circuits have aligned themselves with the Fourth Circuit on this question. See, *e.g.*, *Mojonnier Bros. Co.* v. *Tolan Machinery Co.*, 230 F. 2d 850, 851 (CCA 3rd 1956); *Wasserman* v. *Burgess & Blacher Co.*, 217 F. 2d 402, 404 (CCA 1st 1954). For at least two years this conflict between the circuits has been crying out for resolution by an authoritative decision of this Court.

Finally in this connection we would reiterate that the principal case is an appropriate vehicle by which this Court may resolve the conflict. The trial court held the plaintiff's patent valid. The Court of Appeals reversed the trial court, holding the patent invalid for lack of invention. The standard of invention applied by the Court of Appeals was not consistent with the requirements of Section 103 in that, relying upon the strict test of *Great Atlantic and Pacific Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147, 71 S. Ct. 127 (1950), that Court ignored the many unsuccessful attempts of those skilled in the art to solve the same problem (the test established by Section 103) and invalidated the patent on the basis of some *a priori* postulate of its own manufacture. In so doing, it reaffirmed its holding in *Interstate Rubber Products Corp.* v. *Radiator Specialty Co.*, *supra*, that Section 103 was not intended to temper the strict test laid down in the decisions of this Court which immediately preceded its enactment. In so doing, it also refused to recognize that Section 103 is the sole and exclusive test by which patentable invention must be determined.

As was written by the same commentator whose incisive paper has already been referred to above:



"Applying the 'obviousness' test to specific cases, it must be observed that the cases where it is most difficult to say that the invention would have been obvious to those skilled in the art, are those cases in which the evidence clearly shows that those most skilled in the art have sought a solution to a particular and perplexing problem for many years, but have been without success until the discovery of the patentee. In the *Bausch & Lomb* case, the court found that such a long, concentrated, and unsuccessful search was present. It is only natural that the court should find that it could not invalidate the patent without disregarding the test established by Congress in section 103.

It is submitted that the decision in the *Bausch & Lomb* case is correct on the facts as found by the court, and that its analysis of the effect of section 103, correctly understood, is more in accord with the intent of Congress than any of the other cases which have considered the question." [6]

The same type of "long, concentrated, and unsuccessful search" which was referred to above with reference to the *Bausch & Lomb* case was present in the principal case. Consequently the Court of Appeals for the Fourth Circuit "could not invalidate the patent without disregarding the test established by Congress in Section 103."

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[6] Libert, "Section 103 of the Patent Act and the Standard of Invention: Comments on *Lyon* v. *Bausch & Lomb Optical Co.*," 38 J. Pat. Off. Soc'y. 304, 328 (1956).

III. The Court Of Appeals Decision That The Standard Of Invention Is A Legal Rather Than A Factual Question Is Contrary To The Decisions Of This Court And In Direct Conflict With The Decisions Of The Great Majority Of The Other Courts Of Appeal.

In holding the plaintiff's patent invalid for lack of invention, the Court of Appeals said, "the appropriate standard of invention is a legal, rather than a factual, question." This is directly contrary to the holding of this Court in *Graver Tank & Manufacturing Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 274, 69 S. Ct. 535, 537 (1949), where this Court said through Mr. Justice Jackson:

> "* * * We are now asked to hold that there has been no such invention.
>
> Rule 52(a) of the Federal Rules of Civil Procedure provides in part: 'Findings of fact shall not be set aside unless clearly erroneous and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.' To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations." (p. 274)

See also later opinion in *Graver Tank* case, 339 U. S. 605, 609, 70 S. Ct. 854, 857 (1950); *Thomson Spot Welder Co.* v. *Ford Motor Co.*, 265 U. S. 445, 446, 44 S. Ct. 533, 534 (1924).

The principal case is one in which the chief witness for

each party was an expert witness. The same principles applicable to the *Graver Tank* case are applicable here. The trial judge not only enjoyed the advantage of having considered all of the evidence at first hand but he had the added advantage of having lived for many years in the center of the textile industry and become acquainted with the processes of textile manufacture. Moreover, he had the case under consideration for a period in excess of twenty months, from the time when the defendant's motion for summary judgment was heard and denied in April, 1955 until the announcement of the final decision in January 1957.

It cannot be gainsaid that the Court of Appeals found *clearly* bad a patent which the trial judge had found *clearly* good. The trial judge's opinion states, "A careful study of the record in this case unalterably leads one to the conclusion that the patent in suit is good and valid in law and represents patentable invention." We submit that an appellate court, whose only familiarity with the art in a particular field is derived from a brief encounter with the background of the invention, is of necessity a poor second-guesser on the question of whether or not a given jump from the old to the new required invention. In this case the complete substitution of the appellate court's judgment for that of the trial court has resulted in a further costly setback for patentability in any context.

The decisions of the great majority of the United States Courts of Appeals demonstrate a conflict with the Fourth Circuit on this question. See, *e.g.*

Lincoln Stores v. *Nashua Mfg. Co.*, 157 F. 2d 154, 163 (CCA 1st 1946), cert. denied 329 U. S. 811, 67 S. Ct. 623 (1947);

Schering Corp. v. *Gilbert et al.*, 153 F. 2d 428, 432 (CCA 2nd 1946);

Sutherland Paper Co. v. *Grant Paper Box Co.*, 183 F. 2d 926, 935 (CCA 3rd 1950), cert. denied 340 U.S. 906, 71 S. Ct. 281;

Becton Dickinson & Co. v. *R. P. Scherer Corp.*, 211 F. 2d 835, 843 (CCA 6th 1954);

Texas Co. v. *Globe Oil & Refining Co.*, 225 F. 2d 725, 738 (CCA 7th 1955);

Willis v. *Town*, 182 F. 2d 892, 894 (CCA 8th 1950);

Faulkner v. *Gibbs*, 170 F. 2d 34, 37 (CCA 9th 1948), affirmed 338 U. S. 267, 70 S Ct. 25 (1949).

One other circuit court has sided with the Fourth Circuit in holding that the standard of invention is a question of law. *Blish, Mize and Silliman Hardware Co.* v. *Time Saver Tools, Inc.*, 236 F. 2d 913, 916 (CCA 10th 1956), cert. den. 352 U. S. 1004, 77 S. Ct. 565. The conflict which has arisen between the circuit courts on this question should be resolved in this case. The time is ripe for this Court to confirm that the principles of appellate review apply to patent cases for the same reasons and with the same effect as they apply to cases involving other subject matters.

CONCLUSION

For the reasons set forth in this Petition we respectfully

submit that certiorari should be granted.

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APPENDIX A

UNITED STATES COURT OF APPEALS

FOR THE FOURTH CIRCUIT

No. 7398.

The American MonoRail Company,
Appellant,

versus

Parks-Cramer Company,
Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF NORTH CAROLINA, AT CHARLOTTE.

(Argued April 10, 1957. Decided May 27, 1957.)

Before SOPER and SOBELOFF, Circuit Judges, and PAUL, District Judge.

B. D. Watts (Craighill, Rendleman & Kennedy, J. B. Craighill, Richey, Watts, Edgerton & McNenny, and F. O. Richey on brief) for Appellant, and Joseph W. Grier, Jr. (Taliaferro, Grier, Parker & Poe, Sydnor Thompson, Porter, Chittick and Russell, and Cedric W. Porter on brief) for Appellee.

SOBELOFF, Circuit Judge:

In suit here is a patent relating to an improvement in traveling fans or cleaners installed principally in textile factories to blow lint from spinning and weaving machines and from yarns and fabrics during the manufacturing process. The plaintiff, Parks-Cramer Company, is the owner of patent No. 2,524,797, issued to it on October 10, 1950, as assignee of the inventor, Grover B. Holtzclaw, its research director.[1] The District Court having upheld the plaintiff's contentions on validity and infringement (147 F. Supp. 218), the defendant, The American MonoRail Company, brings the case here on appeal.

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[1]The claim of the patent with which we are particularly concerned is No. 6, as follows: "The combination with a traveling cleaner, for blowing lint, dust, and other foreign particles from longitudinally alined machines having a trackway disposed above and longitudinally centrally of said machines, said cleaner having a motor driven carriage and fan with means operable by said motor for propelling the carriage along the trackway and for rotating said fan, and a fan casing enclosing the fan having an inlet and oppositely positioned outlet conduits, of the construction in which the said conduits present a rigid section terminating above the heads of the machine operator's when standing, and in which the said conduits at each side are provided with a cuff of highly flexible material extending therefrom toward the machines to enable currents of air produced by the fan and discharged through the cuffs to be directed against the machines and the cuffs to yield upon impingement with an operator or other obstruction in their path of travel."

A long-standing problem in the textile industry was that in spinning yarn and weaving it into fabric, minute particles of fibre, called lint, would accumulate on the machines and on the material being processed. This interfered with the proper operation of the machines and caused defects in the product. Various means were employed at different times to remove lint. Before 1925, it was done largely by hand: operators of the spinning or weaving machines would pick off the lint or wipe or brush off the surfaces where it had accumulated. Another but still comparatively primitive method was to pipe compressed air into the spinning room. Attached to the pipe was a long, flexible hose with a nozzle on the end, which the spinning machine operator directed as required. Like the original hand method, this consumed much of the operator's time and was not satisfactory. Later came mechanical cleaners—fans or blowers propelled along tracks suspended from the ceiling or otherwise fixed above the spinning machines. The fan is enclosed in a casing or housing with outlets for the air current. These are now an established feature of cotton mills.

A spinning machine consists of a long base resting on the floor and extending the length of the spinning room. Above are three interspaced boards or shelves, running the length of the base. These are known as creel boards, and they support the bobbins of roving or raw fibre, and the spindles. The boards, together with the equipment they hold, are referred to as the creel, when it is desired to distinguish this part of the machine from the lower part, which is often called the underframe.

Spinning machines are usually arranged in a series of rows, with aisles between the rows. In the aisles, operators pass frequently in attending the machines. The blower

mechanism on the overhead trackway travels the length of the machine slowly and continuously to blow away the lint. But even after the introduction of this overhead apparatus, it remained a problem to get the air in proper volume and intensity between the creel boards, to clean their undersurfaces; and especially the underframe areas were not satisfactorily cleaned by such mechanisms. It still remained necessary to do considerable cleaning by hand.

Conduits of various design, attached to the fan housing, were in use from time to time to direct air currents in the removal of lint from the machines. Holtzclaw's patent application explains that "in usual traveling cleaners, the end of each air conduit extending from the fan casing is provided with two preferably adjustable sleeves or nozzles, one of which directs the blast of air downwardly by the side of the machine therebeneath and the other of which directs the air transversely across the machine." In describing the problem to which he addressed himself, Holtzclaw says: "Each of the sleeves or nozzles usually terminates above the top of the machine and is ineffective in satisfactorily preventing deposition or accumulation of lint and the like upon rigid parts of the machines not located in the direct paths of the blasts of air, or upon mechanism for the material being treated located closely therebeneath. For example, in the use of the traveling cleaner for cleaning a spinning frame, blasts of air are not fully effective in preventing accumulation of lint and the like upon the lower face of the creel board and upon the spools of roving located closely therebeneath and the deposition or accumulation of bunches of lint upon the roving running from said spools."

His specially declared aim was to provide the well known overhead blower type of cleaner, with a nozzle, sleeve, or

cuff that would reach down lower than a man's height, and thereby more effectively prevent the accumulation of lint on the underside of the creel board and on the spools. He undertook to do so with a "highly flexible" cuff which would yield on contact with an obstruction. Previously, such extensions of the conduit or arm were not allowed to go below the normal height of a person standing in the aisle, for although the fan usually traveled at a speed of only one hundred feet per minute, it was deemed unsafe or otherwise undesirable for a part made of rigid material to extend low enough to strike an operator.

The issue is whether, according to applicable legal standards, this is a patentable invention. We conclude that it is not.

The bare idea of using a soft sleeve or pipe to convey air, fluids, or other materials is very old and has been applied many times. Repeatedly it has been held that the use of known devices in an analogous field is not invention. In a not too dissimilar context, the Supreme Court said that such adaptations are "but the display of the expected skill of the calling and involve only the exercise of the ordinary faculties of reasoning. . . ." *Concrete Appliances Co.* vs. *Gomery*, 269 U.S. 177. The patent which was there held invalid was for an apparatus to raise wet concrete at one place in a building under construction and distribute it through spouts to other parts of the building. The Court pointed to the familiar use of similar methods and appliances to distribute water and other mobile substances, such as grain and coal. The arrangement provided by Holtzclaw, which adapts to a particular use the well known flexible pipe, is no more novel than the adaptation effected in the *Gomery* case. The use of flexible pipes is a familiar

commonplace, and not only to engineers. Indeed, any layman who has ever lifted the hood of his automobile will not have failed to notice the use of flexible pipes or tubes connected with rigid conveyors of fluids and gases. Holtzclaw himself testified that he was familiar with the use of a flexible hose attached to a rigid pipe through which fluids or air or sand was passed. As he said, "You can see that at home or anywhere."

Without minimizing the usefulness of Holtzclaw's device, it is still true that not every idea that may be interesting and useful rises to the level of invention. *Ingersoll-Rand Co.* vs. *Black and Decker Mfg. Co.*, 4 Cir., 192 F. 2d 270. Many progressive ideas in business and industry are not patentable. *Great A & P Tea Co.* vs. *Supermarket Corp.*, 340 U.S. 147 (1953).

The commercial success of the plaintiff's product has been heavily stressed, but we do not think that it can aid the patent in this case

Commercial success is not a substitute for invention. It may be invoked to aid a patent only if the question of invention is doubtful. In the *Great A & P* case, above cited, the alleged invention consisted of a three-sided frame, with no top or bottom, which, when pushed or pulled across a store counter, moved the articles deposited within it by a customer to the checking clerk and left them there when it was pushed back to repeat the operation. The device worked as claimed, speeded the customer, and saved checking costs for the merchant. Indisputably, it had a quick and widespread commercial success, but it was held unpatentable for lack of invention.

Each patent case in which the issue of invention is raised presents a separate problem, and it is difficult to find a sure guide in any prior decision. Nevertheless, we must endeavor as best we may to derive from the adjudicated cases a general principle with respect to the question of invention. In our view, prior decisions illustrative of the general principle indicate the absence of invention here. In *Atlantic Works* vs. *Brady*, 107 U.S. 192, for example, the patentee devised a complicated piece of machinery, consisting of a specially designed propeller-like means for dredging rivers, and devices for flooding compartments of a boat at will for the purpose of sinking it to the desired draught of water, and with pumps to remove the mud dislodged from the river bottom. In denying patentability, the Court, at page 199, said:

> "The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head-workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention, somewhat above ordinary mechanical or engineering skill, is distinctly shown, is unjust in principle and injurious in its consequences.
> "The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a

shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention."

If the patent for the dredge-boat in that case was invalid, it is difficult to imagine how the flexible cuff here can survive the test of novelty and invention.

Not unmindful of the rule which requires us not to disturb the District Judge's findings of fact unless they are clearly erroneous, we have given his findings deferential consideration. Rule 52a, Federal Rules of Civil Procedure. We must, however, conclude that he fell into error in attributing decisive weight to commercial success. Moreover, the appropriate standard of invention is a legal, rather than a factual, question. We think that, for the lack of invention, the patent should not have been granted in the Patent Office or sustained in the District Court.

Decree reversed with costs.

APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 7398

The American MonoRail Company,
Appellant

versus

Parks-Cramer Company,
Appellee

Appeal from the United States District Court for the Western District of North Carolina.

This cause came on to be heard on the record from the United States District Court for the Western District of North Carolina, and was argued by counsel.

On consideration whereof, It is now here ordered, adjudged and decreed by this Court that the decree of the said District Court appealed from, in this cause, be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the United States District Court for the Western District of North Carolina, at Charlotte, for further proceedings in accordance with the opinion of this Court.

May 27, 1957.

United States Circuit Judge.
SIMON E. SOBELOFF